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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,465	09/17/2003	John W. Schnell	PTG 02-103-6	4340

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SUITER WEST SWANTZ PC LLO
14301 FNB PARKWAY
SUITE 220
OMAHA, NE 68154

EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,465

Applicant(s)

SCHNELL ET AL.

Examiner

Thanh K. Truong

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
4a) Of the above claim(s) 27-49 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-26 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 17 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/20/03
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment received on March 28, 2005.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-26 in the reply filed on March 28, 2005 is acknowledged. The traversal is on the ground(s) that the search and examination of Groups I, II and III would necessarily overlap, and therefore not to pose any undue burden upon the examiner. This is not found persuasive because:

These inventions are distinct and have acquired a separate status in the art because of their recognized divergent subject matter, and their different classification.

Each group (I, II and III) is classified in a different class and subclass, and because the search required for Group I is not required for Group II or III and vice versa. Furthermore, multiple subclasses also require for the search of each group.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 27-49 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on March 28, 2005.

Specification

3. The disclosure is objected to because of the following informalities:

The part names and the reference numbers of paragraph [0016] and [0018] are inconsistent and confusing. For example, in paragraph [0016] "first angular connection site 130" and "second angular connection site 132", but in paragraph [0018] "a first pick-off rib 132" and "the second pivot-head 130", etc. Other paragraphs should also be checked for the similar informalities.

Appropriate correction is required.

Drawings

4. The drawings are objected to because on Figure 2B, the reference number 134 is pointed to a bolt, but on page 8, paragraph [10018], line 5, reference 134 is referred to "a second pick-off rib 134". Other Figures should also be checked for the similar informalities.

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the following features:

- "an articulating pusher assembly" recited in claims 5 and 17,
- "a nail checker assembly" recited in claims 6 and 18,
- "a nail lockout assembly" recited in claims 7 and 19,
- "a nail spacing verification assembly" recited in claims 8 and 20,
- "a nail shank pawl assembly" recited in claims 9 and 21,
- "a pinion nail verification assembly" recited in claims 10 and 22,
- "a top load and a side load nail loading assembly" recited in claims 11 and 23,
- "a modular nail loading assembly" recited in claims 12 and 24, and
- "a clutch assembly" recited in claims 14 and 26,

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 5-12, 14, 17-24 and 26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The following features:

- "an articulating pusher assembly" recited in claims 5 and 17,
- "a nail checker assembly" recited in claims 6 and 18,
- "a nail lockout assembly" recited in claims 7 and 19,
- "a nail spacing verification assembly" recited in claims 8 and 20,
- "a nail shank pawl assembly" recited in claims 9 and 21,
- "a pinion nail verification assembly" recited in claims 10 and 22,
- "a top load and a side load nail loading assembly" recited in claims 11 and 23,
- "a modular nail loading assembly" recited in claims 12 and 24, and
- "a clutch assembly" recited in claims 14 and 26.

Although in paragraph [0021] these features are mentioned, there is no disclosure to explain or to describe the functioning of these features.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 2, 5-12 and 14-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation "an adjustment assembly" in claims 2 and 15 cannot be found in the disclosure. Therefore, it is unclear to what the applicant is referring?

The following claimed features:

- "an articulating pusher assembly" recited in claims 5 and 17,
- "a nail checker assembly" recited in claims 6 and 18,
- "a nail lockout assembly" recited in claims 7 and 19,
- "a nail spacing verification assembly" recited in claims 8 and 20,
- "a nail shank pawl assembly" recited in claims 9 and 21,
- "a pinion nail verification assembly" recited in claims 10 and 22,
- "a top load and a side load nail loading assembly" recited in claims 11 and 23,
- "a modular nail loading assembly" recited in claims 12 and 24, and
- "a clutch assembly" recited in claims 14 and 26,

are mentioned in paragraph [0021], but there are no explanations or descriptions of how these elements function, therefore, it is unclear what are the metes and bounds of the claims.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

11. Claims 1, 3, 4, 13, 15, 16 and 25 are rejected under 35 U.S.C. 102(a) as being anticipated by Chen (6,431,428).

Chen discloses an apparatus comprising:

a housing (20) suitable for storing a nail (50) and providing the nail to the nail driving assembly, and

a pick-off pivot assembly (the pivoting point to couple the magazine 20 and the barrel 16) coupled to the housing, the pick-off pivot assembly for pivotally coupling the housing to the nail driving assembly and providing the nail to the nail driving assembly,

wherein the pick-off pivot assembly enables the nail loading assembly to be positioned at various angles relative to the nail driving assembly and presents the nail to the nail driving assembly in the correct position (column 1, lines 35-41).

an adjustment assembly (as best understood by the examiner) disposed proximal to the second end of the housing, the adjustment assembly (13, 22, 23, 132) for affixing the position of the housing relative to the nail gun (column 1, lines 29-41).

Chen further discloses: a cover coupled with the housing, the cover being removable from the housing (figure 1 shows that the cover of the housing is removable from the housing), and wherein the nail gun is a pneumatic nail gun (abstract).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

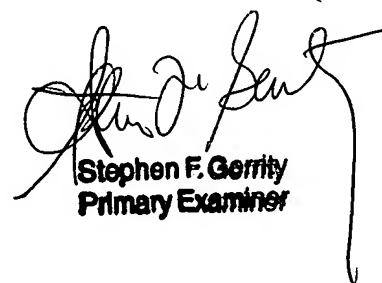
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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tkt
June 4, 2005.



Stephen F. Gerny
Primary Examiner